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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.         | CONFIRMATION NO. |
|-----------------|-------------|----------------------|-----------------------------|------------------|
| 09/597,513      | 06/20/2000  | Alan Collmer         | 19603/3306 (CRF<br>D-2136B) | 5828             |

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EXAMINER

KUBELIK, ANNE R

ART UNIT

PAPER NUMBER

1638

DATE MAILED: 05/07/2003

20

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Applicati n No.

09/597,513

Applicant(s)

COLLMER ET AL.

Examin r

Anne R. Kubelik

Art Unit

1638

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 April 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 20 December 2002. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☒ affidavit, b) ☒ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: \_\_\_\_\_.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☒ Other: See Continuation Sheet

## Continuation of 2. NOTE:

New matter: there appears to be no support for the phrase "followed by wash conditions effective to remove DNA that binds non-specifically to the DNA molecule".

New issues: 112, 2nd. Claims 1 and 4 are indefinite in their recitation of "binds non-specifically". It is unclear what level of hybridization is considered non-specific and what level is considered specific.

## Continuation of 5. does NOT place the application in condition for allowance because:

112, 1<sup>st</sup>, new matter: Applicant points to hybridization data in Example 10 in which HrpW hybridizes to a band of DNA in genomic DNA blots from other *P. syringae* strains to show they were in possession of DNAs from sources other than *P.s. pv tomato*. Applicant also introduced the phrase to exclude the nucleic acid taught by Lorang et al; Lorang et al is incorporated by reference into the instant specification. This is not found persuasive because there is no support for the idea that the claimed invention is from a *P. syringae* strain other than *P.s. pv tomato*. The specification claims all nucleic acids that hybridize to SEQ ID NO:1 and that encode a hypersensitive response elicitor other than those from various *Erwinia* species or *P.s. pv syringae* (see paragraph spanning pg 10-11). The blot of GFig. 3 includes *P.v. pv tomato*. Additionally, it is noted that hybridization in a Southern blot does not show possession of ISOLATED DNAs.

112, 1<sup>st</sup>, enablement: Applicant urges that claims to transformed plants have been cancelled, making that part of the enablement rejection moot. Applicant urges that the hybridization conditions have been described in sufficient detail to enable one of skill in the art to isolate the claimed DNA. Applicant cites Sambrook et al to state that hybridization between DNAs that are 200 nucleotides long are stable while shorter DNAs are not. Applicant urges that the presence of HrpW homologs in other Gram-negative bacteria has been demonstrated by Southern hybridization. Applicant cited Guttman et al to also show that HrpW homologs exist in other bacteria. Applicant urges that the recitation of hybridization conditions and the teaching of assays for hypersensitive response elicitors enables the invention. Applicant also urges that hypersensitive response elicitor proteins have a characteristic amino acid composition and properties. This is not found persuasive because the hybridization conditions are not fully taught (what are the washing conditions)? the sequences of the HrpW homologs are also not taught.

112, 1<sup>st</sup>, written description: Applicant urges that one of ordinary skill in the art would realize that Applicant was in possession of nucleic acids encoding HrpW homologs. This is not found persuasive because the structural features of these nucleic acids are not described.

102: because the wash conditions are not recited, the amendments would not overcome the rejection over Tabakaki or Bauer et al.

## Continuation of 10. Other:

The amendment to the specification would be entered if presented with allowable claims.

Claims 2 and 3 would be allowable if presented independently.

The declaration of Michael Krogh provides support for the phrase "hybridization medium that contains about 1.7M Na<sup>+</sup>".

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PRIMARY EXAMINER  
GROUP 180-1638

